

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

44702-42635

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on January 18, 2006Signature Joseph M. RolnickiTyped or printed name Joseph M. Rolnicki

Application Number

10/797,267

Filed

March 10, 2004

First Named Inventor

David A. Senften

Art Unit

3617

Examiner

Le, Mark T.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 32,653

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Joseph M. Rolnicki
SignatureJoseph M. Rolnicki

Typed or printed name

(314) 552-6286

Telephone number

January 18, 2006

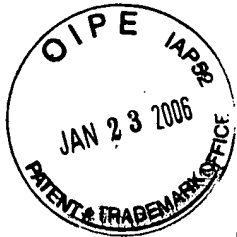
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

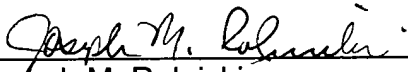
If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being sent via First Class Mail to Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on January 18, 2006.


Joseph M. Rolnicki
Reg. No. 32,653

In re application of:
Senften

Serial No.: 10/797,267

Filed: March 10, 2004

For: MAGNETIC COUPLING AND
UNCOUPLING SYSTEM FOR
MODEL RAILROAD ROLLING
STOCK

Examiner: LE, MARK T.

Group Art Unit: 3617

Mail Stop AF
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

It is requested that the Final Rejection of claims 2-9 be reviewed in view of the following remarks.

REMARKS

Claims 2-9 were rejected as being anticipated by the disclosure of the U.S. patent of Takahashi. Of the rejected claims, claims 2 and 9 are independent claims. The Takahashi reference does not identically disclose the subject matter of claims 2 and 9, and therefore does not anticipate these claims.

It is important to consider all of the features of the invention recited in independent claim 2 when comparing the claim to the Takahashi reference. The rejection of claim 2 contends that the side-by-side orientation of the first and second surface areas is identically disclosed by figure 10 of Takahashi. Figure 10 of the Takahashi reference discloses a circular end surface of the magnet 4 that is not positioned transverse to the draw bar length, but is positioned parallel to the draw bar length. This is clear from viewing figure 8. However, claim 2 requires "the magnetic surface being positioned transverse to the draw bar length." Thus, figure 10 of the Takahashi reference does not identically disclose this feature of the invention recited in claim 2, and therefore does not anticipate claim 2, and claim 2 is allowable over the Takahashi reference.

In the rejection of claims 7 and 8, the Office Action states that figure 9 of Takahashi should be considered. The rejection contends that a center axis running horizontally through the first and second draw bars shown in figure 9 would present symmetrical halves with first and second magnetic surface areas on opposite sides of the center axis. However, claims 7 and 8 both depend from claim 2 which requires that the first surface area and the second surface area be positioned horizontally side by side on the magnetic surface. In viewing figure 9 of Takahashi, what the Examiner

considers to be the first and second surface areas on opposite sides of the center axis passing through the draw bar 3 are positioned vertically side by side, not horizontally side by side as required by claim 2. Because claims 7 and 8 depend from claim 2 and include all of the subject matter of claim 2, figure 9 of the Takahashi reference, which does not disclose first and second surface areas positioned horizontally side by side, does not anticipate the subject matter of claims 7 and 8. Claims 7 and 8 are therefore allowable over the prior art.

In the "Responses to Applicant's Arguments," the Examiner states that figure 8 of the Takahashi reference discloses an outer surface of the cylindrical drum 4 that extends in a horizontal direction transversely to the length of the draw bar 3. The Examiner appears to state that this discloses the claimed magnetic surface that is positioned transverse to the draw bar length with the magnetic surface having a first surface area of a first polarity and a second surface area of a second polarity, the first and second surface areas being positioned horizontally side by side on the magnetic surface. However, the outer surface of the cylindrical drum 4 shown in figure 8 that faces away from the draw bar 3 does not have first and second surface areas of different polarities. The outer surface of the cylindrical drum 4 shown in figure 8 is of one polarity, and the opposite surface of the cylindrical drum 4 of figure 8 that faces toward the draw bar 3 is of an opposite polarity. This is shown in figures 9 and 10 of the referenced drawings. Figure 8 does not disclose a magnetic surface that is transverse to the draw bar length and has first and second surface areas of first and second magnetic polarities that are positioned horizontally side by side as required by claim 2.

The Examiner then refers to figure 10 for a disclosure of a first surface area of "S" polarity and a second surface area of "N" polarity, where the first and second surface areas are positioned horizontally side by side. However, the first and second surface areas shown in figure 10 that are labeled "S" and "N" are not part of a magnetic surface that is positioned transverse to the length of the draw bar 3 as required by claim 2. The circular surface shown in figure 10 is positioned parallel to the draw bar length. Therefore, figure 10 does not disclose all of the features of the invention recited in claim 2.

With regard to independent claim 9, the Examiner takes the position that figure 10 discloses the claimed first and second surface areas of the first draw bar opposing the respective second and first surface areas of the second draw bar. The Examiner states that figure 10 discloses the first surface area of the first draw bar in an opposing contact position with the second surface area of the second draw bar, and the second surface area of the first draw bar in an opposing non-contact position with the first surface area of the second draw bar. However, the non-contacting surfaces of the magnets 4 shown in figure 10 that are labeled "S" and "N" do not oppose each other, but face away from each other. Figure 10 of the reference discloses only one magnet surface of one polarity "N" that opposes a second magnetic surface of a second polarity "S." The other surfaces of the two magnets of opposite polarities do not oppose each other as required by claim 9. Therefore, the Takahashi reference does not identically disclose all of the subject matter of claim 9, and does not anticipate the claim.

In view of the remarks presented above, it is respectfully submitted that claims 2-9 are allowable over the prior art.

Respectfully submitted,

Thompson Coburn LLP

By: Joseph M. Rolnicki
Joseph M. Rolnicki
Reg. No. 32,653
One US Bank Plaza
St. Louis, MO 63101-1693
(314) 552-6286
Fax: (314) 552-7286